

REMARKS

I. Introduction

Claims 11-20 remain pending in this application and have been rejected.

II. Rejection under 35 U.S.C. 102(b)

Claims 11 and 15-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2002/0060553 to Kato ("Kato"). It is respectfully submitted that the claims 11 and 15-20 are not anticipated by Kato for at least the following reasons.

To anticipate a claim under § 102(b), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged exactly as in the claim. Lindeman, 730 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 11 recites the following:

11. A device for **ascertaining an amount of charge** that is able to be drawn from an energy storage unit, **up to at least one specified cutoff threshold**, comprising:
a charge predictor for calculating, **in the case of a specified discharge current characteristic**, the **amount of charge that is able to be drawn** from the

energy storage unit, **on the basis of a mathematical energy storage model** that mathematically represents electrical properties of the energy storage unit; and
an estimator for **ascertaining at least one of state variables and parameters for the mathematical energy storage model**, based on **operating performance quantities of the energy storage unit**.

In support of the rejection, the Examiner cites paragraphs [0030]-[0033] of Kato as disclosing all of the limitations of claim 11. However, the actual text of the cited paragraphs of Kato clearly fails to support the Examiner's contention. Paragraph [0031] of Kato indicates that CPU 1 operates in two different modes, i.e., "indication reference adjusting mode" and "battery life indicating mode." During "**indication reference adjusting mode**," a minimum driving **voltage value** necessary for operations of all functions of the electronic watch is generated, and this minimum voltage value is stored as "**a reference value** corresponding to a **voltage value** necessary for each processing mode of the electronic watch 100." (Kato, ¶[0032]). During the "**battery life indicating mode**," the actual voltage value of a battery is compared with the stored minimum **reference voltage value**, and "**the battery life necessary for the operations of all functions**" is determined "on the basis of the comparison result to indicate the battery life." (Kato, ¶[0033]). The objective of the arrangement disclosed in Kato is to enable **adjustment of "the indication reference of the battery life . . . according to all functions of the electronic device."** (Kato, ¶[0033]). As can be seen from above, the arrangement of Kato is directed to determining "**the battery life necessary for the operations of all functions**" based on the **minimum required voltage value**, which is fundamentally different from "calculating . . . the **amount of charge that is able to be drawn from the energy storage unit**," let alone calculating the amount of charge that is able to be drawn "**in the case of a specified discharge current characteristic**."

Independent of the above, to the extent the Examiner contends that sensor 11 of Kato satisfies the claimed limitation of "an estimator for ascertaining at least one of state variables and parameters for the mathematical energy storage model, **based on operating performance quantities of the energy storage unit**," Applicants submit that this contention is wholly inaccurate. Specifically, sensor 11 of Kato is **a pressure sensor which outputs a detection voltage corresponding to an atmospheric pressure**, and the power supply which

drives the pressure sensor 11 is a sensor driving circuit 12, which is completely different from (and independent of) the **battery 13** (which is the alleged equivalent of the claimed “energy storage unit,” based on the implicit interpretation presented by the Examiner). (*Kato*, ¶[0035]). As such, since the parameters measured by, and the parameters output by, the pressure sensor 11 are completely unrelated to the battery 13, there is no basis to contend that sensor 11 of *Kato* satisfies the claimed limitation of “an estimator for ascertaining at least one of state variables and parameters for the mathematical energy storage model, **based on operating performance quantities of the energy storage unit.**”

For at least the foregoing reasons, claim 11 and claim 19 (which recites substantially similar features as claim 11), as well as dependent claims 15-18 and 20, are allowable over *Kato*.

III. Rejection under 35 U.S.C. 103(a)

Claims 12 to 14 were rejected under 35 U.S.C. 103(a) as unpatentable over *Kato* in view of U.S. Patent No. 2002/0120906 to Xia et al. (“Xia”). It is respectfully submitted that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or

technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

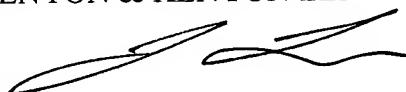
Claims 12 to 14 depends from claim 11. As discussed above, Kato fails to anticipate parent claim 11. In addition, the secondary Xia reference does not cure the critical deficiencies of the primary Kato reference as applied against parent claim 11. Accordingly, without passing judgment on the merits of the Examiner’s contentions regarding the teachings of Xia as applied against the features of dependent claims 12-14, Applicants submit that the overall teachings of Kato and Xia fail to render parent claim 11, and hence its dependent claims 12-14, obvious.

Conclusion

In view of the foregoing, Applicants respectfully submit that all pending claims 11 to 20 are allowable. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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